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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/869,275 06/04/97 WITTWER

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HM22/0423

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EXAMINER
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BARNES & THORNBURG  
11 SOUTH MERIDIAN STREET  
INDIANAPOLIS IN 46204

MARSCHEL, A

ART UNIT	PAPER NUMBER
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1631

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DATE MAILED:

04/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/869,275

Applicant(s)

Wittwer et al.

Examiner  
Ardin Marschel

Art Unit  
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 9, 2001
- 2a) ☒ This action is **FINAL**.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-35, 55-59, 79-82, 87-92, and 118-156 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-35, 55-59, 79-82, 118-121, and 145-151 is/are allowed.
- 6) ☒ Claim(s) 13-32, 87-92, 122-144, and 152-156 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) 2 pages (1 sheet)
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Applicants' arguments, filed 2/9/01, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 13-32, 87-92, 122-144, and 152-156 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have amended the claims, such as claim 13, for example, to require that the light source is positioned to excite the sample during at least a portion of the temperature cycling. Support was pointed to on pages 76-77 and Figure 11. Consideration of said pages 76-77 and Figure 11 has failed to reveal this positioning limitation of the light source for a portion of the temperature cycling or for any portion for that matter. The mere presence of a light source, or the positioning of a carousel of samples, as cited on said pages 76-77 and Figure 11 also does not indicate a light source being positioned in some real time relationship regarding the instantly claimed method. This limitation therefore is NEW MATTER in claims 13, 87, 122, 128, and 152 and claims dependent therefrom. This rejection is

necessitated by amendment.

Claims 13-32 and 128-144 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained and reiterated from the previous office action, mailed 11/9/00. Applicants have removed this limitation from certain claims but that claims that still contain this limitation either directly or via dependence from a claim that does still are deemed to be vague and indefinite due to lacking some actual "real time" limitation in actual claims steps to correspond to this in the preamble. It is noted that claim 13, for example, has been amended to contain NEW MATTER. Even if this were not deemed as NEW MATTER, the amendments do not indicate a "real time" performing or monitoring. For example, the means for detecting fluorescence may be monitored during the reaction and then viewed later. The concept of "real time" indicates some requirement of an ability to evaluate detection data coincidentally when it is being generated. No such coincidence is required in claim 13, for example.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 13, 18, 20, 28, 128, 129, and 140 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either of Jerman (P/N 5,824,204) or Schnipelsky et al. (P/N 5,229,297).

This rejection is maintained and reiterated from the previous office action, mailed 11/9/00. Applicants argue that priority should be granted from the instant claims to parent serial number 08/658,993 which predates the filing date of Jerman. Applicants pointed to various citations in 08/658,993 for priority support. Consideration of these citations reveals that many of the instant claim limitations are not found in said priority document. Therefore this argument is non-persuasive in that priority is not granted to 08/658,993. For example, applicants pointed to page 35, lines 3-14, for the sample container of instant claim 13. Consideration of said page 35 citation reveals that capillary tubes are described but without

any indication of holding less than 1 milliliter or of being optically clear or of having first and second sides and an end. Consideration of page 38 as pointed to by applicants also regarding the sample container also revealed a lack of the above noted optical clarity, walls, end, and holding volume limitations. Positioning means is cited to page 57, lines 4-15. Said page 57 describes a specific carousel with stepper motor etc. but not a word about positioning in a monitoring position as required in instant claim 13, line 6. Instant claim 13, lines 7-10, describes generic heating and cooling means with control means for thermal cycling in a PCR sample. Applicants have pointed to pages 23-25, 29, and 55-56 for support in 08/658,993. Consideration of said pages reveals that a specific blower motor/box/fan configuration is described therein and not the far more generic limitations in instant claim 13, lines 7-10. Such a specific citation fails to support a generic invention disclosure which is vastly broader in scope. A number of added citations in 08/658,993 are then pointed to by applicants, but these are not commented on since the above already prevents a granting of priority to said 08/658,993. In summary, the reference by Jerman is still deemed to be prior art and the rejection based on Jerman is maintained.

Schnipelsky et al. is then argued by applicants. This rejection is also maintained and reiterated from the previous office action, mailed 11/9/00. It is noted that the above

indication of NEW MATTER supports the maintaining of this rejection in anticipation of removal of the NEW MATTER thus leaving the claims rejected as set forth in the previous office action, mailed 11/9/00. No other arguments were set forth by applicants.

Reference ET is initialed on the enclosed PTO Form 1449 as it now has a date of publication as required. The remaining citations are lined through on the enclosed Form 1449 to avoid duplication of citation because they were already previously initialed and cited on various Forms 1449.

The request for correcting the name of the inventor, Carl T. Wittwer, is acknowledged and has been performed in the filing receipt.

Claims 33-35, 55-59, 79-82, 118-121, and 145-151 are allowed.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM

THE DATE OF THIS FINAL ACTION.

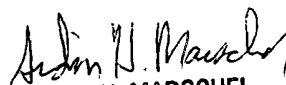
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703)308-0196.

April 20, 2001

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER